

REMARKS/ARGUMENTS

The Office Action mailed October 28, 2005 has been carefully considered.

Reconsideration in view of the following remarks is respectfully requested.

Claims 1, 12, 16, 21, 23, 34, 38 and 40 have been amended to further particularly point out and distinctly claim subject matter regarded as the invention. Support for these changes may be found in the specification, page 11, paragraph 22. The text of claims 2-8, 13-15, 17-19, 22 and 24-30 is unchanged, but their meaning is changed because they depend from amended claims.

With this amendment it is respectfully submitted the claims satisfy the statutory requirements.

The 35 U.S.C. § 112, Second Paragraph Rejection

Claims 5, 6, and 18 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter applicant regards as the invention. This objection is respectfully traversed.

Applicant respectfully submits that the word "ascertaining" is not indefinite. The term as used in claim 5 does not require antecedent basis because it is the first time it is recited. The subsequent use in claim 6 refers back to the act recited in claim 5. While Applicant recognizes that the patent office has assumed the usage of the term "ascertaining" is "discovering", applicant feels that the term "determining" is a more appropriate synonym. Indeed the term "ascertaining"

was used in claim 5 in order to differentiate it from a different act described in claim 1 using the term "determining".

The First 35 U.S.C. § 103 Rejection

Claims 1, 2, 7, 8, 16, 23, 24, 29, 30 and 38 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Lee et al.¹ in view of Rue², among which claims 1, 16, 23 and 38 are independent claims. This rejection is respectfully traversed.

According to the Manual of Patent Examining Procedure (M.P.E.P.),

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.³

Specifically, the Office Action contends that the elements of the presently claimed invention are disclosed in Lee except that Lee does not teach determining if the first switch is a home agent for the client and removing information regarding the client from the first switch if the first switch is not a home agent for the client.⁴ The Office Action further contends that Rue teaches determining if the first switch is a home agent for the client and removing information regarding the client from the first switch if the first switch is not a home agent for the client and that it would be obvious to one having ordinary skill in the art at the time of the invention to

¹ U.S. Patent No. 6,535,493 B1

² U.S. Publication No. 2003/0185172 A1

³ M.P.E.P § 2143.

⁴ Office Action ¶ 1.

incorporate Rue into Lee in order to provide a method of freeing-up resources (i.e., memory) of the non-home agent first switches. The Applicants respectfully disagree for the reasons set forth below.

The Office Action has equated the removing of information regarding the client from the first switch, as claimed in claim 1, with the discarding of the Find request message in Lee. Applicant maintains that this is not a fair comparison. The removing of information regarding the client from the first switch, as claimed in claim 1, involves the removing of information that has already been stored on the switch before the roam request is received. It does not refer to the discarding of the roam request itself. Claim 1 has been amended to make this distinction more clear.

Additionally, the purpose of deleting the client information from the first switch if the first switch is not the home agent is because the client has "roamed away" from the first switch. It would therefore be inappropriate to maintain the client information on a switch that no longer is processing packets to or from the client. The purpose of the removing is not, as the Office Action alleges, merely to free-up resources. Applicant therefore respectfully submits that claim 1 is in condition for allowance.

As to claims 16, 23, and 38, these claims contain elements similar to that of amended claim 1 as described above. As such, Applicant respectfully submits that these claims are also in condition for allowance.

As to dependent claims 2, 7, 8, 24, 29 and 30, the argument set forth above is equally applicable here. The base claims being allowable, the dependent claims must also be allowable.

The Second 35 U.S.C. § 103 Rejection

Claims 9-11, 20, 31-33, 37 and 39 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Rue among which claims 9, 20, 31 and 39 are independent claims. This rejection is respectfully traversed.

Specifically, the Office Action contends that the elements of the presently claimed invention are disclosed in Rue except that Rue does not teach sending a roaming request to itself.⁵ The Office Action further contends that Rue teaches that the switch itself is checked to determine if information on the mobile node is stored in the database and that it would be obvious to one of ordinary skill in the art at the time of the invention to modify Rue to send a roaming request to itself to provide a method of obtaining information on the mobile node from its home switch so that data may appropriately be routed to the roaming mobile node. Applicant respectfully disagrees for the reasons set forth below.

The Applicant is a bit confused on how the Office Action can on the one hand say that Rue is silent on sending a roaming request to itself and then allege it would be obvious from only looking at Rue to modify rue to send a roam request to itself. Applicant assumes that the Office Action intended to take official notice of something based on M.P.E.P. 2144.03, that the rationale supporting the obviousness rejection is based on common knowledge in the art or "well-

⁵ Office Action ¶ 2.

known" prior art. Under M.P.E.P. 2144.03, "[i]f the applicant traverses such an assertion the examiner should cite a reference in support of his or her position." Applicant hereby traverses the assertion and requests that a reference be cited in support of the position outlined in the Office Action.

Nevertheless, the Office Action points to Paragraph 45; 4-7 as showing that the switch itself is checked to determine if information on the mobile node is stored in the database. This is a mischaracterization of the reference. The switch that is being checked for the information in this paragraph is the switch on the receiving end, not the switch on the sending end. Indeed, there is nothing in Rue to teach or suggest that switch on the sending end checking to see if information in a roam request it has sent is contained in its memory. The Office Action was correct in its first point: Rue is silent on sending a roaming request to itself.

Additionally, the Office Action's alleged motivation to combine is not relevant to the claims at issue. The purpose of sending a roam request to itself is described in the Specification in paragraph [0034], namely to handle the case where the client is roaming between two VLANs serviced by the same switch. It is not, as the Office Action alleges, merely to obtain information on the mobile node from its home switch. Applicant therefore respectfully submits that claim 9 is in condition for allowance.

As to claims 20, 31, and 39, these claims contain elements similar to that of amended claim 9 as described above. As such, Applicant respectfully submits that these claims are also in condition for allowance.

As to dependent claims 10, 11, 32, 33 and 37, the argument set forth above is equally applicable here. The base claims being allowable, the dependent claims must also be allowable.

The Third 35 U.S.C. § 103 Rejection

Claim 35 was rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Rue in view of Lee et al. and Edney et al.⁶. This rejection is respectfully traversed.

As to dependent claim 35, the argument set forth above is equally applicable here. The base claims being allowable, the dependent claim must also be allowable.

The Fourth 35 U.S.C. § 103 Rejection

Claims 3, 17 and 18 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Lee et al. and Rue in further view of Eglin⁷. This rejection is respectfully traversed.

As to dependent claims 3, 17, and 18, the argument set forth above is equally applicable here. The base claims being allowable, the dependent claim must also be allowable.

⁶ U.S. Publication No. 2004/0255033 A1

⁷ U.S. Publication No. 2003/0210671 A1

The Fifth 35 U.S.C. § 103 Rejection

Claims 12, 15, 21, 34 and 40 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Lee et al. in view of Rue and Strachen et al.⁸, among which claims 12, 21, 34 and 40 are independent claims. This rejection is respectfully traversed.

Specifically, the Office Action contends that the elements of claim 12 are disclosed in Lee except that Lee does not teach the roam reply having information regarding a client that is roaming to the switch or switching a router designated by the client with a default router for the switch if the handling of the roam request was successful⁹. The Office Action further contends that Rue teaches the roam reply having information regarding a client that is roaming to the switch and Strachan teaches switching a router designate by the client with a default router for the switch if the handling of the roam request was successful, and that it would be obvious to one having ordinary skill in the art at the time of the invention to incorporate Rue and Strachan into Lee in order to provide a method of enabling seamless roaming of mobile devices among wireless networks. The Applicants respectfully disagree for the reasons set forth below.

The Office Action in appropriately mixes elements of Lee in order to attempt to teach the stated elements of claim 12. Specifically, the Office Action claims that Lee teaches handling a roam reply at a switch and uses Col. 8, lines 13-15 as evidence of this. Col. 8, lines 13-15 describe a foreign agent receiving a roam reply from a home agent. The Office Action then goes on to allege that Lee teaches determining if the roam reply indicates that the handling of a roam

⁸ U.S. Publication No. 2004/0105440 A1

⁹ Office Action ¶ 5.

request was successful, and uses Col. 9, lines 57-61 as evidence of this. Col. 9, lines 57-61 describe a home agent sending a predetermined code to the foreign agent (which may be used to determine success or failure of the roam request). The Office Action, however, then goes on to allege that Lee teaches sending a reply to a corresponding access point indicating failure if the handling of the roam request was not successful, and uses the same Col. 9, lines 57-61 to support this. This is inappropriate. Either this section of Lee teaches sending a roam reply to the foreign agent or the sending of a reply to a corresponding access point, but not both, as it only teaches a single communication including the predetermined code. The Office Action is attempting to have it both ways, which is inappropriate.

The Office Action further alleges that Rue teaches the roam reply having information regarding a client that is roaming to the switch, and indicates that Rue's inclusion of an internet protocol (IP) address of the client in the roam reply indicates Rue's teaching of this element. Applicant respectfully disagrees, however claim 12 has been amended to make clear that the information that is coming to the switch in the roam reply is information that it does not currently have. It is not meaningless header information such as the IP address of the client, information that it would already have since it sent the roam request. Applicant therefore respectfully submits that claim 12 is in condition for allowance.

As to claims 21, 34, and 40, these claims contain elements similar to that of amended claim 12 as described above. As such, Applicant respectfully submits that these claims are also in condition for allowance.

As to dependent claim 15, the argument set forth above is equally applicable here. The base claims being allowable, the dependent claim must also be allowable.

The Sixth 35 U.S.C. § 103 Rejection

Claims 13 and 22 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Lee et al., Rue and Strachan et al., in further view of Edney et al. This rejection is respectfully traversed.

As to dependent claims 13 and 22, the argument set forth above is equally applicable here. The base claims being allowable, the dependent claim must also be allowable.

The Seventh 35 U.S.C. § 103 Rejection

Claim 14 was rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Lee et al., Rue and Strachan et al., in further view of Eglin. This rejection is respectfully traversed.

As to dependent claim 14, the argument set forth above is equally applicable here. The base claims being allowable, the dependent claim must also be allowable.

In view of the foregoing, it is respectfully asserted that the claims are now in condition for allowance.

Conclusion

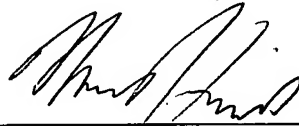
It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698.

Respectfully submitted,

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